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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/529,817	03/31/2005	Jean Binet	11123.0094USWO	6251
23552	7590	07/26/2007	EXAMINER	
MERCHANT & GOULD PC			SOLOLA, TAOFIQ A	
P.O. BOX 2903			ART UNIT	PAPER NUMBER
MINNEAPOLIS, MN 55402-0903			1625	
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			07/26/2007	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

**Application No.**

10/529,817

**Applicant(s)**

BINET ET AL.

**Examiner**

Taofiq A. Solola

**Art Unit**

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☐ Claim(s) 1-16 and 21-30 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) 1-16, 21-30 are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |  |
|---|--|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                      | 5) <input type="checkbox"/> Notice of Informal Patent Application                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date ____ | 6) <input type="checkbox"/> Other: ____  |

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Claims 1-16, 21-30 are pending in this application.

Claims 17-20 are cancelled.

## **DETAILED ACTION**

### ***Election/Restriction***

Claims 1-16, 21-30 are drawn to more than one inventive concept (as defined by PCT Rule 13) and, accordingly, a restriction is required according to the provision of PCT Rule 13.2.

PCT Rule 13.1 states that the international application shall relate to one invention only or to a group of inventions so linked as to form a single general inventive concept (requirement of unity of invention).

PCT Rule 13.2 states that unity of invention referred to in Rule 13.1 shall be fulfilled only when there is a technical relationship among those inventions involving one or more of the same or corresponding special technical features.

Annex B, Part 1(b), provides that "special technical features" mean those technical features which, as a whole, define a contribution over the prior art (novelty/unobviousness).

I. Claims 1-12, 15-16, 25-30, drawn to examples 1-7, 13-16, 18-23, 30-41, 46-50, 54, 59, 61, 67-68, 70-73, 75-76, 83-84, 87, 91, 93, 101, 104, 113, 115, 117, 122-134, 187-189, 191, 193, 195, 200-202, 206, 210, 212, 214-216, 224, 226-228, 230-233, 236-237, 239-240, 243-249 and composition thereof, classifiable in several non-heterocyclic classes (558, 562, etc.), numerous subclasses.

II. Claims 1-12, 15-16, 25-30, drawn to examples 8-9, 17, 24-25, 52, 58, 60, 77, 86, 88, 97, 99, 110, 112, 121, 135, 186, 192, 196, 205, 207-209, 229, 234, and composition thereof, classified in several heterocyclic classes (540, 544, 544, 548, 546) and non-heterocyclic classes (558, 562, etc.), numerous subclasses.

III. Claims 1-12, 15-16, 25-30, drawn to examples 10-12, 55-56, 63-66, 78-82, 85, 92, 94-96, 98, 103, 136-137, 185, 197-198, 203, 211, 219-220, 223, 238, 241 and composition thereof, classified in several heterocyclic classes (540, 544, 544, 548, 546) and non-heterocyclic classes (558, 562, etc.), numerous subclasses.

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IV. Claims 1-12, 15-16, 25-30, drawn to examples 45, 51, 53, 57, 62, 69, 74, 190, 199, 204 and composition thereof, classifiable in several heterocyclic classes (540, 544, 544, 548, 546) and non-heterocyclic classes (558, 562, etc.), numerous subclasses.

V. Claims 1-12, 15-16, 25-30, drawn to examples 42, 90, and composition thereof, classifiable in several heterocyclic classes (540, 544, 544, 548, 546) and non-heterocyclic classes (558, 562, etc.), numerous subclasses.

VI. Claims 1-12, 15-16, 25-30, drawn to examples 29, 89, 105, 194, 213, 217 and composition thereof, classifiable in several heterocyclic classes (540, 544, 544, 548, 546) and non-heterocyclic classes (558, 562, etc.), numerous subclasses.

VII. Claims 1-12, 15-16, 25-30, drawn to example 43, and composition thereof, classifiable in several heterocyclic classes (540, 544, 544, 548, 546) and non-heterocyclic classes (558, 562, etc.), numerous subclasses.

VIII. Claims 1-12, 15-16, 25-30, drawn to examples 26-27, and composition thereof, classified in several heterocyclic classes (540, 544, 544, 548, 546) and non-heterocyclic classes (558, 562, etc.), numerous subclasses.

IX. Claims 1-12, 15-16, 25-30, drawn to examples 28, 111, 225, and composition thereof classified in several heterocyclic classes (540, 544, 544, 548, 546) and non-heterocyclic classes (558, 562, etc.), numerous subclasses.

X. Claims 1-12, 15-16, 25-30, drawn to examples 44, 106, 218, 221-222, and composition thereof classified in several heterocyclic classes (540, 544, 544, 548, 546) and non-heterocyclic classes (558, 562, etc.), numerous subclasses.

XI. Claims 1-12, 15-16, 25-30, drawn to example 107, and composition thereof classified in several heterocyclic classes (540, 544, 544, 548, 546) and non-heterocyclic classes (558, 562, etc.), numerous subclasses.

XII. Claims 1-12, 15-16, 25-30, drawn to example 235, and composition thereof classified in several heterocyclic classes (540, 544, 544, 548, 546) and non-heterocyclic classes (558, 562, etc.), numerous subclasses.

XIII. Claims 1-12, 15-16, 25-30, drawn to examples 114, 120, 242, and composition thereof, classified in several heterocyclic classes (540, 544, 544, 548, 546) and non-heterocyclic classes (558, 562, etc.), numerous subclasses.

XIV. Claims 1-12, 15-16, 25-30, drawn to example 116, and composition thereof, classified in several heterocyclic classes (540, 544, 544, 548, 546) and non-heterocyclic classes (558, 562, etc.), numerous subclasses.

XV. Claims 1-12, 15-16, 25-30, drawn to example 118, and composition thereof, classified in several heterocyclic classes (540, 544, 544, 548, 546) and non-heterocyclic classes (558, 562, etc.), numerous subclasses.

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XVI. Claims 1-12, 15-16, 25-30, drawn to example 119 and composition thereof, classified in several heterocyclic classes (540, 544, 544, 548, 546) and non-heterocyclic classes (558, 562, etc.), numerous subclasses.

XVII. Claims 1-12, 15-16, 25-30, drawn to examples 138, 146, 148, 150, 167 and composition thereof, classified in several heterocyclic classes (540, 544, 544, 548, 546) and non-heterocyclic classes (558, 562, etc.), numerous subclasses.

XVIII. Claims 1-12, 15-16, 25-30, drawn to examples 139-141, 144-145, 154, 156-157, 162-163, 165-166, 169-170, 172-184 and composition thereof, classified in several heterocyclic classes (540, 544, 544, 548, 546) and non-heterocyclic classes (558, 562, etc.), numerous subclasses.

XIX. Claims 1-12, 15-16, 25-30, drawn to examples 142-143, 147, 149, 152, 158-161, 164, 168, 171 and composition thereof, classified in several heterocyclic classes (540, 544, 544, 548, 546) and non-heterocyclic classes (558, 562, etc.), numerous subclasses.

XX. Claims 1-12, 15-16, 25-30, drawn to examples 151, 153, 155 and composition thereof, classified in several heterocyclic classes (540, 544, 544, 548, 546) and non-heterocyclic classes (558, 562, etc.), numerous subclasses.

XXI. Claims 1-12, 15-16, 25-30, drawn to examples 100, 102, 108 and composition thereof, classified in several heterocyclic classes (540, 544, 544, 548, 546) and non-heterocyclic classes (558, 562, etc.), numerous subclasses.

XXII. Claims 1-12, 15-16, 25-30, drawn to example 109, and composition thereof, classified in several heterocyclic classes (540, 544, 544, 548, 546) and non-heterocyclic classes (558, 562, etc.), numerous subclasses.

XXIII. Claims 1-12, 15-16, 25-30, drawn to none of the examples above but within the scope of formula I, and composition thereof, classified in several heterocyclic classes (540, 544, 544, 548, 546) and non-heterocyclic classes (558, 562, etc.), numerous subclasses.

XXIV. Claims 13-14, drawn to a process of making compounds of groups I-XXIII, classified in several heterocyclic classes (540, 544, 544, 548, 546) and non-heterocyclic classes (558, 562, etc.), numerous subclasses.

XXV. Claims 21-24, drawn to methods of using compounds of groups I-XXIII, classified in several heterocyclic classes (514, 544, 544, 548, 546) and non-heterocyclic classes (558, 562, etc.), numerous subclasses.

In the instant inventions, the only structural element shared by groups I-XXV is 2-thiohydantoin. However, 2-thiohydantoin is well known in the art. See compounds VIII and IX, Soliman et al., J. Pharm. Sc. (1981) Therefore, under PCT Rules 13.1 and 13.2, 2-thiohydantoin does not constitute a corresponding special technical feature among the groups.

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If applicant elect the invention of group XXIII, applicant must identify the compounds embraced by the group.

If applicant elects the invention of group XXIV or XXV or in a rejoinder thereof, one of groups I-XXIII must be selected and the elected group would be examined commensurate in scope therewith.

In a telephone call made to Gregory Sebald on 7/10/07, to request an oral election to the above restriction requirement, but did not result in an election being made.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

### ***Rejoinder***

The examiner has required restriction between product and process claims. Where applicant elects claims directed to the product, and the product claims are subsequently found allowable, withdrawn process claims that depend from or otherwise require all the limitations of the allowable product claim will be considered for rejoinder. All claims directed a nonelected process invention must require all the limitations of an allowable product claim for that process invention to be rejoined.

In the event of rejoinder, the requirement for restriction between the product claims and the rejoined process claims will be withdrawn, and the rejoined process claims will be fully examined for patentability in accordance with 37 CFR 1.104. Thus, to be allowable, the rejoined claims must meet all criteria for patentability including the requirements of 35 U.S.C. 101, 102,

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103 and 112. Until all claims to the elected product are found allowable, an otherwise proper restriction requirement between product claims and process claims may be maintained.

Withdrawn process claims that are not commensurate in scope with an allowable product claim will not be rejoined. See MPEP § 821.04(b). Additionally, in order to retain the right to rejoinder in accordance with the above policy, applicant is advised that the process claims should be amended during prosecution to require the limitations of the product claims. **Failure to do so may result in a loss of the right to rejoinder.** Further, note that the prohibition against double patenting rejections of 35 U.S.C. 121 does not apply where the examiner before the patent issues withdraws the restriction requirement. See MPEP § 804.01.

#### ***Telephone Inquiry***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Taofiq A. Solola, PhD. JD., whose telephone number is (571) 272-0709. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Janet Andres, can be reached on (571) 272-0867. The fax phone number for this Group is (571) 273-8300.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (571) 272-1600.



**TAOFIQ SOLOLA  
PRIMARY EXAMINER**

Group 1626

July 16, 2007